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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,476	04/22/2004	Yoshihisa Nagano	740819-1052	5876
22204 7590 11/25/2008 NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128				
EXAMINER				
WILSON, SCOTT R				
ART UNIT		PAPER NUMBER		
2826				
MAIL DATE		DELIVERY MODE		
11/25/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/829,476

Applicant(s)

NAGANO ET AL.

Examiner

SCOTT R. WILSON

Art Unit

2826

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Response to Amendment

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Applicant's arguments (pages 4-6, filed 3/3/2008) in regard to the art rejection of 4/5/2007 with respect to claim 1, have been fully considered and are persuasive.

Reissue Applications

The Application Data Sheet filed 8/11/2004 is objected to because of the following informalities: The continuity data erroneously states that the application is a reexamination of 6,441,420, when in fact it is a reissue. Appropriate correction is required.

The amendment to the claims filed on 3/3/2008 does not comply with the requirements of 37 CFR 1.173(d), which requires that deletions from the patent text be put in brackets and additions underlined. 37 CFR 1.173(g) requires that all amendments be made relative to the patent. Claim 1, filed 3/3/2008, must be rewritten to include each of the deleted limitations, "wherein an edge portion of the capacitor upper electrode is formed onto the protective insulating film" and "direct", placed between brackets.

The supplemental reissue oath/declaration filed 3/3/2008 with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

A broadening reissue application must be applied for by all of the inventors (patentees), that is, the original reissue oath or declaration must be signed by all of the inventors. See also MPEP § 1414. **If a supplemental oath or declaration in a broadening reissue application is needed in the application in order to fulfill the requirements of 37 CFR 1.175, the supplemental reissue oath or declaration must be signed by all of the inventors.** See *In re Hayes*, 53 USPQ2d 1222 (Comm'r Pat. 1999) and

Art Unit: 2826

MPEP § 1414.01. A supplemental reissue declaration by the *assignee* is not available in a broadening reissue.

Claims 1-7 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claimed subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of the claimed subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. See also MPEP 1412.02.

The claim limitation in the reissue which provides the broadening aspect, and which was not present in the application for patent is "wherein an edge portion of the capacitor upper electrode is formed onto the protective insulating film". In the parent case, 09/576791 (Attorney Docket No. 0819-379) the amendment filed 9/28/2001, which was in response to the non-final rejection mailed 7/2/2001, narrowed the scope of claim 1 by inserting the limitations "wherein an edge portion of the capacitor upper electrode is formed onto the protective insulating film" between "protective insulating film" and "a first contact". The amendment also inserted "the edge portion of" between "second field-effect transistor and" and "the capacitor upper electrode". This language was inserted in response to the 35 U.S.C. 102(b) rejection over applicants admitted prior art.

Art Unit: 2826

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT R. WILSON whose telephone number is (571)272-1925. The examiner can normally be reached on M-F 8:30 - 4:30 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sue Purvis can be reached on 571-272-1236. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

srw

/Sue A Purvis/
Supervisory Patent Examiner, Art Unit 2826